

PATENT

Attorney Docket No.: 057309-5001-US

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: David M. LONG *et al*

U.S. Application No.: 10/018,551

Filed: July 2, 1999

For: IN VIVO ADDITION OF TELOMERIC  
REPEATS TO EXOGENOUS DNA GENERATES  
EXTRACHROMOSOMAL DNAs IN THE  
FUNGUS *PESTALOTIOPSIS*

Group Art Unit: not assigned

Examiner: not assigned

Attention: International Division, Legal Staff  
Box PCT  
Commissioner for Patents  
Washington, D.C. 20231

Sir:

**STATEMENT OF FACTS IN SUPPORT  
OF A PETITION UNDER 37 C.F.R. § 1.47(a)**

I, Rebecca W. Mahurin, Ph.D., declare as follows:

1. I reside at 5 West Cleveland St., Bozeman, Montana 59715.
2. I am Director of the Technology Transfer Office at Montana State University.
3. U.S. Patent Application No. 10/018,551, based on PCT/US99/15129, was originally assigned to Research and Development Institute, Inc. at reel 013436 frame 0009.
4. Montana State University maintains that it is assignee to the entire right and title to U.S. Patent Application No. 10/018,551 as the subject matter of this application was developed by employees of Montana State University using the facilities and equipment of Montana State University.
5. David M. Long is an original named inventor of U.S. Patent Application No. 10/018,551 based on PCT/US99/15129.
6. David M. Long was employed by Montana State University beginning in July 1998. David M. Long terminated his employment with Montana State University in December

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1999. I believe the current address of David M. Long is 414 S. 8th Street, Livingston, MT 59047.

7. On October 16, 2002, responsibility for the prosecution of the above captioned patent application was transferred back to Montana State University from Research and Development Institute, Inc. at reel 013444, frame 0889.
8. On November 20, 2002, I telephoned David M. Long and requested that he sign a combined Declaration and Power of Attorney for the above captioned application. Dr. Long said that he would not sign the document. A copy of my notes from this conversation are attached as Exhibit A.
9. On January 8, 2003, I sent David M. Long, via certified mail, a full copy of the above captioned application, including claims, drawings, assignment, combined declaration and power of attorney and a letter requesting signature where required on each document. In this letter I indicated that given David Long's statements in our November 20, 2002 telephone conversation, if we did not receive the documents within two weeks of mailing this will constitute a refusal to sign. A copy of this letter is attached as Exhibit B.
10. On January 18, 2003 David Long received the aforementioned documents as evidenced by a Domestic Return Receipt that he signed. A copy of the Domestic Return Receipt is attached as Exhibit C.
11. As of today, David M. Long has not responded to our request to sign the aforementioned documents.
12. I further declare that all statements made herein of our own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-referenced patent.

Dated: 3/17/03By: Rebecca W. Mahurin, Ph.D.

Rebecca W. Mahurin, Ph.D.

Director of the Technology Transfer Office,  
Montana State University

Phone Call Notes  
Long, David  
11-20-02

41114-5002-US  
10/01/02  
and  
47714-5001-US  
10/018, 551

I called David Long at home and left a message on his voice mail on the morning of November 20, 2002. (Home number 406-222-9416)

David returned my call less than an hour later and left on my voice mail his work number to call. (Work number 406-222-2986)

I called David back at the work number later in the morning of November 20, 2002. I asked if it was a problem to talk at work and he stated, "No."

I explained that RDI was now dissolved, and that all technology transfer matters were now being handled by my office. He asked why. I explained that it was an efficiency and cost saving move on the part of the University.

I then explained that I was working with the patent attorneys regarding the Telomerase patents. I asked if he would be willing to sign the assignments for the PTO, thus making it easier for us to obtain patents on these technologies. He responded that he would not be willing to sign. He said it was not in his best interests to sign. He said that we could proceed in any way we wanted to, and he would not try to interfere.

He explained that MSU had not been loyal to him and not done anything when he was not hired into a position in the Plant Sciences Department. He said that MSU could have given him lab space and a salary and he would have been happy to continue working at MSU, but that did not happen.

He said he did not harbor any grudges against me and knew that I had always been interested in him and his technology.

I explained that I would be sending him a letter for his signature. I would appreciate it if he would reconsider, but it was his option to either sign or not sign. He also stated that it would not be possible for MSU to patent without his signature. He asked if that was correct. I stated that it was my understanding that we may still be able to patent. He said he didn't see how we could exclude him as an inventor. I explained that he would be included as an inventor. I also stated that if we ever received any remuneration for this technology that we would share with him as though he had been cooperative. He said I should know that this issue was not about money. I told him I knew that, but that MSU would not deprive him of revenues. He said he appreciated that.

This was a friendly conversation. David and I have always had friendly conversations and this was no different.

LDM-1997-PESTAL



OFFICE OF TECHNOLOGY TRANSFER

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January 7, 2003

David Long, Ph.D.  
414 South 8<sup>th</sup>  
Livingston, MT 59047

Dear David:

Thank you for speaking with me on November 20, 2002 regarding the patent applications, "Taxol Production via Generation of Extrachromosomal DNAs in the Fungus Pestalotiopsis" and "In Vivo Addition of Telomeric Repeats to Exogenous DN Generates Extrachromosomal DNAs in the Fungus Pestalotiopsis."

In the November 20<sup>th</sup> conversation you stated that you would not sign the Assignments and Powers of Attorney for either of the above listed patent applications. I am sending to you the specifications for each of the two application listed above, including claims, drawings, Assignments and Combined Declaration and Powers of Attorney. I have marked each signature requirement with a blue sticky note labeled "sign." I ask that you please promptly sign and return the enclosed documents. Given that you have stated your refusal to sign documents for these two applications during our phone conversation of November 20, if we do not receive the documents from you within the next two weeks, this will constitute a refusal to sign.

I continue to desire to work with you in this matter, David. Please give this request your consideration. Should you have questions regarding this letter or matters related to these patent applications, please call me at 994-2752.

Thank you for your consideration of this request.

Sincerely,

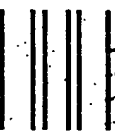
A handwritten signature in cursive script that reads "Rebecca W. Mahurin".

Rebecca W. Mahurin, Ph.D.  
Director, Technology Transfer Office

f-5001-US  
4-5002-US

SENDER: COMPLETE THIS SECTION		COMPLETE THIS SECTION DELIVERY	
<ul style="list-style-type: none"><li>Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.</li><li>Print your name and address on the reverse so that we can return the card to you.</li><li>Attach this card to the back of the mailpiece, or on the front if space permits.</li></ul>		<p>A. Signature <b>X</b> <i>David M. Long</i> <input type="checkbox"/> Agent <input type="checkbox"/> Addressee</p> <p>B. Received by (Printed Name) <i>David M. Long</i> C. Date of Delivery <i>7-18-03</i></p> <p>D. Is delivery address different from item 1? <input type="checkbox"/> Yes If YES, enter delivery address below: <input checked="" type="checkbox"/> No</p>	
1. Article Addressed to:  David Long 414 S. 8th St. Livingston, MT 59047-3303		3. Service Type <input checked="" type="checkbox"/> Certified Mail <input type="checkbox"/> Express Mail <input type="checkbox"/> Registered <input type="checkbox"/> Return Receipt for Merchandise <input type="checkbox"/> Insured Mail <input type="checkbox"/> C.O.D.	
2. Number (Transfer from service label)		4. Restricted Delivery? (Extra Fee) <input type="checkbox"/> Yes	
PS Form 3811, August 2001		Domestic Return Receipt	
		102595-01-M-0381	

UNITED STATES POSTAL SERVICE



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USPS  
Permit No. G-40

• Sender: Please print your name, address, and ZIP+4 in this box •

Rebecca W. Mahurin  
Montana State University  
Technology Transfer Office  
900 Technology Blvd., Ste. A  
Bozeman, MT 59718-4011

